

REMARKS

I. Introduction

In the Current Action, the Examiner:

- Withdraws claims 34 – 39;
- Rejects Claims 1, 2, 4, 8, 23 and 48 under 35 U.S.C. § 102 (b);
- Rejects Claims 2, 3, 5-7, 9-14, and 49-51 under 35 U.S.C. § 103 (a);
- Objects to claims 15 – 22, 24 – 33 and 52 – 54 as containing allowable subject matter but depending from rejected claims; and
- Allows claims 40 – 47.

This Response:

- Amends claims 1, 2, and 48;
- Amends claims 15 and 24 so that they now appear in independent form;
- Cancels claim 23; and
- Traverses the outstanding rejections.

No new matter has been added, and claims 1 – 22 and 24 – 54 remain pending in the present application.

II. Restriction Requirement

The Applicants note that their traversal of the restriction requirement was timely and, that, under 37 C.F.R. 1.144, the Applicants may petition the Commissioner to review the requirement. Applicants further note that the petition may be deferred until after final action or allowance of the claims of the elected invention, but not later than appeal. The errors in the restriction requirement, as described by the Applicants in the Election filed on September 26, 2003, will not be repeated for the sake of brevity, but are incorporated herein by reference.

III. Claims 15 and 24

Claims 15 and 24 have been rewritten to now appear in independent form. The Current Action indicates that these claims contain allowable subject matter, and the Applicants respectfully ask the Examiner to now allow them. As claims 16 – 22 depend either directly or indirectly from allowable claim 15 and claims 25 – 33 depend either directly or indirectly from allowable claim 24, the Applicants respectfully ask the Examiner to allow claims 16 – 22 and 25 – 33 as well.

IV. Rejections Under 35 U.S.C. § 102 (b)

In the Current Action, the Examiner maintains that claims 1, 4, 8, 23 and 48 are anticipated by one of a plurality of references. Claim 23 is now canceled, thus the rejection of claim 23 is moot. Although believing the claims filed to be patentable over the art of record, the Applicants wish to facilitate prosecution and have amended claim 1 to include “wherein said isolation circuit is constructed, at least in part, using wave guide techniques,” substantially as originally submitted in claim 2, and amended 48 to include “wherein said connecting means is constructed, at least in part, using a wave guide.” The Applicants respectfully submit that claims 1 and 48 contain limitations, specifically a wave guide and wave guide techniques, that are not found in any of the references cited. Claims 4 and 8 depend from claim 1, and therefore, also contain limitations not taught by the cited references. The Applicants respectfully ask the Examiner to withdraw the rejections of claims 1, 4, 8, and 48.

V. Claims Rejected Under 35 U.S.C. § 103 (a)

In the Current Action, the Examiner rejects claims 2, 3, 5 – 7, 9 – 14, and 49 – 51 as obvious. The Applicants respectfully remind the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, the examiner must propose a combination of references, or a modification to a single reference, that teaches or suggests each and every limitation of the rejected claims. Second, there must be some suggestion or motivation to combine reference teachings or to modify the reference found, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. Third, the combination or modification must have inspired a reasonable expectation of

success. *See* M.P.E.P. § 2143. The Applicants respectfully submit that the Current Action fails to establish a prima facie case.

The Current Action rejects claims 2 and 49 as obvious over *Bushue et al.*, U.S. Patent No. 5,845,190 (hereinafter *Bushue*). Claim 2 recites “wherein said isolation circuit is constructed, at least in part, using a co-planar wave guide,” and claim 49 recites “wherein said connecting means is constructed, at least in part, using co-planar wave guide techniques.” In the Current Action, the Examiner concedes that *Bushue* fails to teach these limitations, but maintains that it would be obvious to modify *Bushue* to meet these or similar limitations as they “are unremarkable conventional design practices that [are] well known to be used” with the other limitations of claim 1 (the Applicants assume the Examiner intended to include claim 48 as well).

In response, the Applicants respectfully assert that the Examiner’s proposed modification fails to meet the criteria mandated by M.P.E.P. § 2143. First, it appears that the Examiner has taken Official Notice that it is well known in the art to construct both isolation circuits and connecting means using co-planar wave guide techniques. In light of the Examiner’s statements, the Applicants believe that the Examiner has relied on his own personal knowledge, and, under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claims 1 and 48 should be withdrawn.

Second, even if the Examiner’s assertions are assumed correct and that such practices were known in the art, the Current Action still fails to provide any motivation as to why *Bushue* would be modified to employ them. The mere statement that such practices are known is insufficient, because “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.” *See* M.P.E.P. § 2143.01. The Applicants themselves have indicated at page 9 of the disclosure that employing wave guide techniques can, among other things, minimize the parasitic effects of circuit elements on the RF signal. But the Examiner may not rely on the disclosure of the present application in finding motivation for the necessary modifications to the applied art, because “the teaching or suggestion to make

the claimed combination and the reasonable expectation of success must be found in the prior art, not in the [Applicants'] disclosure." *See* M.P.E.P. § 2143. Therefore, the Applicants respectfully assert that the Current Action fails to establish a prima facie case for obviousness in rejecting claims 2 and 49, and respectfully ask the Examiner to withdraw the rejections.

Claim 14 recites an "RF receiver within said interface circuit and receives RF signals for delivery to said RF input from an RF transmitter contained within said interface circuit." Although not specifically addressed by the Current Action, it appears that the Examiner believes that these limitations are also "unremarkable conventional design practices." However, none of the references cited appear to teach or suggest these limitations, as is required by M.P.E.P. § 2143 for establishing a prima facie case. Therefore, the Current Action fails to establish a prima facie case of obviousness with respect to claim 14, and the Applicants respectfully ask the Examiner to withdraw the rejection. If the Examiner intends to take official notice of these features, the Applicant respectfully requests that, under Rule 37 C.F.R. § 1.104(d)(2), the Examiner provide either an affidavit setting forth his data or a reference that supports the assertion.

In addition, claims 2 – 14 all depend, either directly or indirectly, from claim 1, and claims 49 – 54 all depend, either directly or indirectly, from claim 48. Thus, each claim inherits limitations that are neither anticipated nor obvious in light of *Bushue*. The Applicants, therefore, respectfully ask the Examiner to withdraw the anticipation rejection of claims 4 and 8, and withdraw the obviousness rejection of claims 2, 3, 5 – 7, 9 – 14, and 49 – 54.

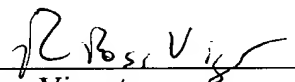
VI. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe that a fee of \$43.00 is due with this response. However, if there is any further amount due, please charge Deposit Account No. 06-2380, under Order No. 49581/P026US/10025288 from which the undersigned is authorized to draw.

Dated: March 30, 2004

Respectfully submitted,

By 

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